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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184978
Party	Defendant Walgreen Co.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

McNEIL-PPC, Inc.)	In re Trademark Application
)	Serial No. 76/682,070
Opposer,)	Opposition No. 91184978
)	Trademark: WAL-ZYR
v.)	
)	
WALGREEN COMPANY,)	
)	
Applicant.)	

CONTESTED MOTION TO AMEND ANSWER

Pursuant to 37 C.F.R. § 2.107, Fed. R. Civ. P. 15(a), and TBMP § 507, Applicant Walgreen Company (“Walgreens”) moves for leave to amend its Answer to add the affirmative defense of a lack of standing, as shown on Exhibit A submitted herewith. Opposer McNEIL-PPC, Inc. (“McNeil”) would not consent to this Motion. In support of this Motion, Walgreens states as follows:

1. Under the Federal Rules of Civil Procedure, the primary purpose of pleadings is to give fair notice of the claims or defenses asserted in a case. TBMP § 507.01 and cases cited therein.

2. The Trademark Trial and Appeal Board (the “Board”) liberally grants leave to amend pleadings at any stage of the proceeding, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. Fed. R. Civ. P. 15(a); TBMP § 507.02. Indeed, the Board must freely give leave to amend pleadings when justice so requires. TBMP § 507.02.

3. Walgreens is seeking to add to the Answer the affirmative defense of lack of standing. This addition amounts to only one sentence at the end of the Answer. (See Exhibit A).

4. Entry of the proposed amendment would not violate settled law. It also would not be prejudicial to McNeil’s rights, because McNeil must show it has standing in order to succeed in this Opposition, McNeil still has ample time to revisit the issue of standing during the

discovery period, which does not close until November 4, 2009, and the defense of lack of standing has not been waived.

5. The purpose of this Motion is to ensure McNeil has fair notice of the defense of lack of standing. Granting this Motion would avoid a situation wherein McNeil could claim it did not have notice of the defense.

6. By way of background, on July 1, 2008, McNeil filed Opposition No. 91184978 against registration of Walgreens' application No. 76/682,070 for the WAL-ZYR mark.

7. McNeil based the Opposition on an alleged likelihood of dilution of and confusion with the ZYRTEC mark, and in particular, Reg. No. 2,204,253. McNeil claimed that UCB Pharma, S.A. owns Reg. No. 2,204,253 and that McNeil is UCB's exclusive U.S. licensee for use of the ZYRTEC mark in connection with over-the-counter allergy medicine. (See Notice of Opposition, Para. 13).

8. On August 8, 2008, Walgreens filed an Answer to McNeil's Notice of Opposition. At the time, Walgreens did not have information sufficient to form a belief as to whether UCB owned Reg. No. 2,204,253 or whether McNeil was UCB's licensee, so Walgreens denied the allegations in its Answer.

9. The parties proceeded with discovery. Walgreens served McNeil with discovery requests that called for documents and information that show McNeil is UCB's licensee.

10. In response, McNeil produced certain documents and information, but Walgreens does not agree that the documents and information show that McNeil is UCB's licensee.

11. Walgreens counsel sent several e-mails to McNeil's counsel, in which Walgreens' counsel explained why Walgreens did not believe the documents and information show that McNeil is UCB's licensee. On July 29, 2009, the parties' respective counsel had a telephone conference to discuss the issue of standing. McNeil's counsel represented during that call and in subsequent e-mails that McNeil maintains its position that it has shown it is UCB's licensee. Walgreens still does not agree and will raise the defense of lack of standing if the issue is not resolved to Walgreens satisfaction.

12. To ensure McNeil has fair notice of the defense of lack of standing, Walgreens decided to move the Board to amend the Answer to add this defense. Walgreens asked McNeil to consent to such a Motion. McNeil said it would not consent, because it believes the defense of lack of standing is groundless. Again, Walgreens does not agree.

13. Accordingly, Walgreens hereby files this contested Motion. Walgreens has good cause to amend its Answer by adding the affirmative defense of lack of standing, and the Board should grant this Motion in the interest of justice. Entry of the amended Answer would not violate settled law or be prejudicial to the rights of McNeil. The amendment serves only to notify McNeil of Walgreens concerns about McNeil's allegations of standing, which McNeil must prove in order to succeed in this Opposition. Therefore, Walgreens respectfully moves the Board to grant this Motion and enter the amended Answer as shown on Exhibit A submitted herewith.

Respectfully submitted,

Date: August 19, 2009

s/Caroline L. Stevens
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EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

McNEIL-PPC, Inc.)	In re Trademark Application
)	Serial No. 76/682,070
Opposer,)	Opposition No. 91184978
)	Trademark: WAL-ZYR
v.)	
)	
WALGREEN COMPANY,)	
)	
Applicant.)	

APPLICANT'S FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION

In the matter of Application Serial No. 76/682,070 for registration of the mark “WAL-ZYR” by Walgreen Company (hereinafter “Applicant”), which was filed on September 19, 2007, Applicant hereby submits its Answer to the Notice of Opposition filed by McNeil-PPC, Inc. (hereinafter “Opposer”) as follows:

Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the corporate allegations relating to Opposer as contained in the un-numbered introductory Paragraph of the Notice of Opposition and, therefore, denies each and every allegation therein. Answering further, Applicant denies that Opposer will be damaged by registration of Applicant’s mark as alleged in the un-numbered introductory Paragraph of the Notice of Opposition. Applicant admits that it has sought to register Application Serial No. 76/682,070 for the mark “WAL-ZYR,” and said application was filed on September 19, 2007 as alleged in the un-numbered opening Paragraph of the Notice of Opposition and that Opposer has initiated this Opposition proceeding.

1. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 of the Notice of Opposition and, therefore, denies each and every allegation therein.

2. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 2 of the Notice of Opposition and, therefore, denies each and every allegation therein.

3. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 3 of the Notice of Opposition and, therefore, denies each and every allegation therein.

4. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 4 of the Notice of Opposition and, therefore, denies each and every allegation therein.

5. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 5 of the Notice of Opposition and, therefore, denies each and every allegation therein.

6. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 6 of the Notice of Opposition and, therefore, denies each and every allegation therein.

7. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 7 of the Notice of Opposition and, therefore, denies each and every allegation therein.

8. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 8 of the Notice of Opposition and, therefore, denies each and every allegation therein.

9. Applicant admits that an allergy medication known as ZYRTEC is available over-the-counter as alleged in Paragraph 9 of the Notice of Opposition. Answering further, Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 9 of the Notice of Opposition and, therefore, denies each and every allegation therein.

10. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 10 of the Notice of Opposition and, therefore, denies each and every allegation therein.

11. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 11 of the Notice of Opposition and, therefore, denies each and every allegation therein.

12. Applicant denies that ZYRTEC is well known and famous as alleged in Paragraph 12 of the Notice of Opposition. Answering further, Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 12 of the Notice of Opposition and, therefore, denies each and every allegation therein.

13. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in the first sentence of Paragraph 13 of the Notice of Opposition concerning Opposer's alleged status as an exclusive licensee of UCB and, therefore, denies each and every such allegation. Applicant lacks sufficient information with which to

form a belief as to the truth or falsity of the remaining allegations contained in the first sentence of Paragraph 13 of the Notice of Opposition and, therefore, denies each and every allegation therein. Answering further, Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in the second sentence of Paragraph 13 of the Notice of Opposition relating to whether the registration is valid, subsisting and in full force and effect and, therefore, denies those allegations. Answering further, the remaining allegations contained in the second sentence of Paragraph 13 of the Notice of Opposition are legal conclusions to which no answer is required. To the extent an answer is required, Applicant denies those allegations. Applicant admits that a document purporting to be Exhibit A was attached to the Notice of Opposition as alleged in the third sentence of Paragraph 13 of the Notice of Opposition. Applicant further admits that said document appears to be a printout from the USPTO TARR web server, but lacks knowledge of the remaining allegations in the third sentence of Paragraph 13 and therefore denies the same.

14. Applicant admits the allegations contained in Paragraph 14 of the Notice of Opposition.

15. Applicant admits the allegations contained in Paragraph 15 of the Notice of Opposition.

COUNT I—LIKELIHOOD OF CONFUSION

16. Applicant repeats and reasserts its answers to Paragraphs 1-15 above as its answers to Paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations contained in Paragraph 17 of the Notice of Opposition.

18. Applicant admits that it uses its WAL-ZYR mark in connection with allergy medicine as alleged in Paragraph 18 of the Notice of Opposition. Answering further, Applicant denies the remaining allegations contained in Paragraph 18 of the Notice of Opposition.

19. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 19 of the Notice of Opposition concerning how Opposer has targeted or intends to target customers for its ZYRTEC product and, therefore, denies those allegations. Answering further, Applicant admits that it has targeted and intends to target customers who require allergy medications for its WAL-ZYR product. Answering further, Applicant denies the remaining allegations contained in Paragraph 19 of the Notice of Opposition.

20. Applicant admits that one of the ways it markets and intends to market its WAL-ZYR product is next to or in close proximity to Opposer's product on Applicant's shelves as alleged in Paragraph 20 of the Notice of Opposition. Answering further, Applicant denies that it intends to market its WAL-ZYR product "in Opposer's in-store display units" as alleged in Paragraph 20 of the Notice of Opposition.

21. Applicant denies each and every allegation contained in Paragraph 21 of the Notice of Opposition.

22. Applicant denies each and every allegation contained in Paragraph 22 of the Notice of Opposition.

23. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 23 of the Notice of Opposition relating to UCB's adoption and use of the ZYRTEC mark and, therefore, denies each and every allegation therein.

24. Applicant admits it has sold ZYRTEC in its retail pharmacies since about when the product was first available. Answering further, Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 24 of the Notice of Opposition and, therefore, denies each and every allegation therein.

25. Applicant denies each and every allegation contained in Paragraph 25 of the Notice of Opposition.

COUNT II--DILUTION

26. Applicant repeats and reasserts its answers to Paragraphs 1-25 above as its answers to Paragraph 26 of the Notice of Opposition

27. Applicant denies the allegations contained in Paragraph 27 of the Notice of Opposition.

28. Applicant admits that it adopted and applied to register WAL-ZYR with some general awareness of the ZYRTEC mark. Answering further, Applicant denies that it adopted and applied to register WAL-ZYR with full knowledge of the prior use and alleged fame of the ZYRTEC mark as alleged in Paragraph 28 of the Notice of Opposition.

29. The allegations contained in Paragraph 29 of the Notice of Opposition are legal conclusions to which no answer is required. To the extent an answer is required, Applicant denies those allegations.

30. Applicant denies each and every allegation contained in Paragraph 30 of the Notice of Opposition.

AFFIRMATIVE DEFENSE 1

Applicant has developed a family of marks using the prefix “WAL-,” including such marks as “WAL-DRYL,” Registration Number 2,167,642 and “WAL-HIST,” Registration Number 2,167,643, among others. The public has come to know Applicant and its goods by marks using the distinctive “WAL-” prefix. Further, Applicant’s own “WALGREENS” mark has become famous and associated in the minds of consumers with quality goods due to extensive use, advertising and marketing of that mark and products bearing such mark. Consumer awareness of Applicant and its famous “WALGREENS” and family of “WAL-“ marks like “WAL-HIST,” “WAL-DRYL” and others negates any potential confusion with Opposer and its mark.

AFFIRMATIVE DEFENSE 2

Opposer lacks standing to bring this opposition and cannot claim the benefits of Registration No. 2,204,253.

Respectfully submitted,

Date: August 19, 2009

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above foregoing Applicant's First Amended Answer to Notice of Opposition was mailed by first class mail, postage prepaid on this 19th day of August, 2009 to:

Laura Popp-Rosenberg
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, NY 10017

s/Caroline L. Stevens
Caroline L. Stevens

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I hereby certify that a true and correct copy of the above foregoing “Contested Motion to Amend Answer” was mailed by first class mail, postage prepaid on August 19, 2009 to:

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s/Caroline L. Stevens
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